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UNITED STATES PATENT AND TRADEMARK OFFICE

11-25-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

TRADEMARK TRIAL AND APPEAL BOARD

PRAIRIE ISLAND INDIAN COMMUNITY,)	Opposition No. 115,866
)	and
Petitioner,) Cancellation Nos. 28,126; 28,127; 28,130;
)) 28,133; 28,145; 28,155; 28,199; 28,248;
v.) 28,280; 28,294; 28,314; 28,319; 28,325;
)) 28,342; 28,379
TREASURE ISLAND CORPORATION,)	
)	
Registrant.)
)	

**REGISTRANTS' REPLY IN SUPPORT OF ITS MOTION TO COMPEL
PRODUCTION OF DOCUMENTS, TO DEFINE SCOPE OF THE WAIVER
OF THE ATTORNEY-CLIENT PRIVILEGE, AND TO EXTEND DISCOVERY**

Registrant Treasure Island Corporation ("TIC") respectfully submits this reply in support of its motion to compel production of documents, define the scope of Prairie Island's waiver of the attorney-client privilege, and to extend the discovery period.

Based on a complete mischaracterization of TIC's motion, Prairie Island erroneously argues that TIC's motion is improperly before the Court.

First, Prairie Island falsely argues that TIC is seeking an order compelling production of documents from a third-party, Dorsey & Whitney, LLP, Prairie Island's former trademark counsel. To the contrary, TIC's motion clearly states that it is seeking an order compelling Prairie Island to produce all documents within its possession, custody or control, which, as a matter of law, includes documents within the possession of its outside counsel, Dorsey & Whitney.

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Second, Prairie Island falsely claims that TIC is asking the Board to reconsider its May 8, 2002, order regarding the scope of Prairie Island's waiver of the attorney-client privilege. To the contrary, TIC is simply asking the Board to rule on the application of the May 8, 2002, order to a new discovery dispute. Prairie Island is refusing to produce documents from its former trademark counsel, Dorsey & Whitney, based on the contention that Prairie Island's waiver of the attorney-client privilege did not extend to privileged communications with any attorneys other than Gregory Sebald of Merchant & Gould. TIC believes that Prairie Island's waiver of the attorney-client privilege extended to the subject matter of the voluntarily disclosed communications, not simply the communications with a specific attorney.

Third, Prairie Island erroneously argues that TIC is seeking an order compelling William Hardacker to appear for deposition. To the contrary, TIC is seeking "an order instructing Prairie Island that it cannot assert the attorney-client privilege (or allow Hardacker to assert the privilege on its behalf) to avoid producing Hardacker for a deposition in this case." TIC's motion at 16. Hardacker initially refused to appear for deposition on the grounds that all of the information he has is subject to the attorney-client privilege. Although Hardacker eventually agreed to appear for deposition, Prairie Island's counsel indicated that it would not allow Hardacker to testify regarding certain allegedly privileged subjects, which prompted the postponement of the deposition pending the Board's ruling on the scope of Prairie Island's waiver of the privilege.

By mischaracterizing the nature of TIC's motion, Prairie Island is obviously attempting to shift the Board's attention away from the merits of TIC's motion and Prairie Island's obvious discovery failure -- including its failure to disclose over the course of three years of discovery the existence of eighteen (18) Dorsey & Whitney documents.

As set forth below, none of Prairie Island's arguments provide any legitimate basis for denying the relief requested by TIC.

I. TIC Is Not Seeking Reconsideration of the Board's May 8, 2002, Order; TIC is Asking for a Ruling on How the Order Applies to Documents that Prairie Island is Withholding

A. TIC's Motion is Not A Motion for Reconsideration

By falsely characterizing TIC's motion to compel as a motion for reconsideration, Prairie Island disingenuously argues that TIC's motion is untimely. See Opp. at 4-7. TIC is not seeking reconsideration of the Board's May 8, 2002, order. Rather, TIC is asking the Board to compel Prairie Island to produce Dorsey & Whitney documents withheld from production based on the attorney-client privilege. TIC believes that Prairie Island waived the privilege with respect to the subject matter of these documents as set forth below.

B. Prairie Island's Waiver of the Attorney-Client Privilege Extended to the Subject Matter of the Disclosed Communications, Not Merely Communications with a Particular Attorney

In its opposition, Prairie Island argues that the Board's May 8, 2002, order held that the scope of the attorney-client waiver extended only to communications between attorney Gregory Sebald of Merchant & Gould and Prairie Island. Opp. at 10. The only privileged communications that were the subject of the May 8, 2002, order were communications between Prairie Island and Sebald. Accordingly, the Board's order was couched in terms of communications between the same attorney and the same client.

Since that time, TIC has learned that Prairie Island failed to disclose the existence of documents reflecting communications between Prairie Island and its subsequent trademark counsel, Whitney & Dorsey. Now, TIC seeks an order compelling production of these documents on the basis that Prairie Island's waiver of the privilege extended to all privileged communications on the same subject matter, regardless of which attorney was party to the communications.

TIC's construction of the Board's May 8, 2002, order was fully explained in TIC's opening motion and will not be repeated here. However, TIC wants to bring to the Board's attention the authorities holding that waiver of the attorney-client privilege extends to the subject matter of disclosed communications, regardless of the particular attorney who is a party to the communications. See Helman v. Murray Steaks, Inc., 728 F. Supp. 1099, 1103 (D. Del. 1990) (voluntary disclosure of privileged communications with some attorneys resulted in waiver of privilege on same subject matter as to all attorneys); Beneficial Franchise Co. v. Bank One, 205 F.R.D. 212, 217 (N.D. Ill. 2001) (waiver extends not only to "other communications and opinions of the same attorney, but also privileged information from other counsel involving the same subject"); GFI, Inc. v. Franklin Corp., 265 F.3d 1268, 1273 (Fed. Cir. 2001) (waiver extends to "all communications pertaining to the subject matter of the [privileged] communications").

Indeed, it would be unfair to allow Prairie Island to selectively waive the privilege with respect to its communications with Sebald, but not its communications with its subsequent trademark counsel, Dorsey & Whitney. Such a rule would encourage parties to shop for attorneys who will give them favorable opinions and then waive the privilege only with respect to the favorable opinions, while concealing unfavorable opinions obtained from different counsel on the same subject.

Accordingly, TIC respectfully requests that the Board hold that Prairie Island's waiver of the attorney-client privilege extends to communications between Prairie Island and any of its counsel on the subject matter identified in the Board's May 8, 2002, order.

II. Prairie Island Has Failed to Provide Any Legitimate Basis for Failing to Produce the Dorsey & Whitney Documents

A. TIC is Not Seeking Any Relief Against Dorsey & Whitney

Prairie Island attempts to avoid producing the Dorsey & Whitney documents by misleadingly implying that TIC is asking the Board for an order compelling Dorsey & Whitney to produce the documents at issue. Opp. at 16-17. To the contrary, TIC is asking the Board to order Prairie Island to produce the Dorsey & Whitney documents, because the documents are within Prairie Island's possession, custody or control.

B. The Dorsey & Whitney Documents are Within Prairie Island's Possession, Custody or Control

Prairie Island does not dispute or even address the fact that the Dorsey & Whitney documents at issue are within Prairie Island's possession, custody or control. Moreover, Prairie Island does not dispute or even address the fact that it has failed to comply with its obligations under Rule 34 of the Federal Rules of Civil Procedure by failing to produce or disclose on a privilege log all of the Dorsey & Whitney documents.

Rule 34 provides that a party must produce all documents within its "possession, custody or control." Fed. R. Civ. Proc. 34. The case law clearly provides that "possession, custody or control" includes documents that a party has a legal right to obtain. See Poole v. Textron, Inc., 192 F.R.D. 494 (D. Md. 2000). Documents within the possession of a party's attorney or former attorney are within the "control" of the party within the meaning of Rule 34. See id. "[T]he clear rule is that documents in the possession of a party's *current or former* counsel are deemed to be within that party's 'possession, custody and control.'" Johnson v. Askin Capital Management, L.P., 202 F.R.D. 112, 114 (S.D.N.Y. 2001) (citations omitted); Axler v. Scientific Ecology Group, Inc., 196 F.R.D. 210 (D. Mass. 2000) ("a party must produce otherwise discoverable documents that are in his attorneys' possession, custody or control").

C. Prairie Island Has Failed to Meet its Burden of Establishing that the Dorsey & Whitney Documents Withheld from Production are Privileged

Prairie Island had the duty to produce the Dorsey & Whitney documents or, at a minimum, disclose their existence on a privilege log. Correspondence obtained by TIC through discovery indicates that the Dorsey & Whitney documents were in the possession of Prairie Island's counsel since 1998. See Exhibit A hereto (letter from Dorsey & Whitney to Joseph Halloran, dated September 4, 1998, transmitting Prairie Island's trademark files). TIC happened to learn of the existence of Dorsey & Whitney documents through the deposition of Sebald on August 1, 2002. Prairie Island's failure to list the Dorsey & Whitney documents on a privilege log constitutes a waiver of the privilege.

Moreover, even in the absence of a waiver, Prairie Island has failed to meet its burden of establishing that the Dorsey & Whitney documents withheld from production are privileged. The "General Subject" that Dorsey & Whitney listed for each of the documents does not indicate that the documents reflect communications between Dorsey & Whitney and Prairie Island with respect to giving or receiving any legal advice. See McCue Decl. Exh. M. More importantly, even assuming that the documents reflect advice regarding the TREASURE ISLAND mark (including TIC's registrations and the cancellation of the Saint Maarten Registration), Prairie Island has put the advice at issue and has waived the privilege with respect to the subject matter of the advice as discussed in Section I above.

Dorsey & Whitney (on behalf of Prairie Island) also cited work product protection for ten (10) of the eighteen (18) documents. In its opposition, Prairie Island provides no basis for claiming work product protection for any of the Dorsey & Whitney documents. Instead, Prairie Island attempts to meet its burden of proof by merely claiming without explanation or support that work product protection was "property asserted" Opp. at 18.

Based on the foregoing points, Prairie Island has failed to establish that any of the eighteen (18) Dorsey & Whitney documents are protected by the attorney-client privilege or the work product doctrine. Moreover, Prairie Island's failure to list these eighteen (18) documents on its privilege log constitutes a waiver of the privilege. Accordingly, the Board should order Prairie Island to produce the Dorsey & Whitney documents at issue.

III. Prairie Island Has Failed to Explain its Failure to Produce Billing Records from Dorsey & Whitney and Merchant & Gould

In its opposition, Prairie Island completely ignores its failure to produce billing records from Merchant & Gould or from Dorsey & Whitney. It is well established that attorney billing statements are not privileged. See Bieter v. Bloomquist, 156 F.R.D. 173 (D. Minn. 1994); Rayman v. American Charter Federal Savings & Loan Ass'n, 148 F.R.D. 647 (D. Neb. 1993); Real v. Continental Group, Inc., 116 F.R.D. 211, 213-14 (N.D. Cal. 1986). Accordingly, Prairie Island should be ordered to produce the billing records from Merchant & Gould and Dorsey & Whitney.

IV. Prairie Island Has Failed to Respond to TIC's Contention that Prairie Island Has Failed to Comply with its Discovery Obligations

In its motion, TIC requested an order requiring Prairie Island to conduct a more thorough search for documents responsive to TIC's document requests. TIC's request was based on Prairie Island's failure to disclose the existence of several relevant documents in this case. Prairie Island did not disclose the existence of any Merchant & Gould documents or any Dorsey & Whitney documents until after TIC served subpoenas on these law firms. Moreover, Prairie Island failed to disclose all of the Merchant & Gould and Dorsey & Whitney documents on privilege logs. Accordingly, TIC requested that the Board order Prairie Island to conduct a full search for all documents prepared by or for Prairie Island by any of its inside or outside counsel relating in any way to the TREASURE ISLAND mark and provide a complete and detailed privilege log to enable TIC and the

Board to determine whether the documents are in fact privileged or protected by the work product doctrine or whether the documents should be produced. Since Prairie Island did not oppose this request in its opposition, TIC requests that the Board grant the requested relief.

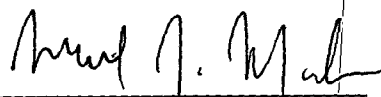
CONCLUSION

The Board should grant TIC's motion to compel.

DATED: November 25, 2002

Respectfully Submitted,

QUIRK & TRATOS

By 

Michael J. McCue
Nancy Ramirez Ayala
3773 Howard Hughes Parkway
Suite 500 North
Las Vegas, Nevada 89109
(702) 792-3773 - telephone
(702) 792-9002 - facsimile

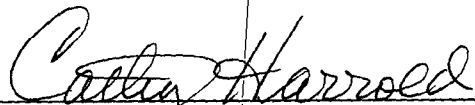
Counsel for Registrant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **REGISTRANTS' REPLY IN SUPPORT OF ITS MOTION TO COMPEL PRODUCTION OF DOCUMENTS, TO DEFINE SCOPE OF THE WAIVER OF THE ATTORNEY-CLIENT PRIVILEGE, AND TO EXTEND DISCOVERY** was served on November 25, 2002, by placing the same in the U.S. Mail with first-class postage prepaid, to Petitioner's counsel of record, as follows:

Henry M. Buffalo, Jr.
Joseph F. Halloran
JACOBSON, BUFFALO, SCHOESSLER & MAGNUSON, Ltd.
246 Iris Park Place
1885 University Avenue West
Saint Paul, Minnesota 55104

Orrin Haugen
Eric Haugen
HAUGEN LAW FIRM PLLP
121 South Eighth Street, Suite 1130
Minneapolis, Minnesota 55402


An employee of Quirk & Tratos

I, Kathleen Harrold, do hereby certify that the above-referenced document is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Trademarks, BOX TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on the date below.


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Cancellation Nos. 92028126
28127; 28130; 28133; 28145;
28155; 28199; 28248; 28280;
28294; 28314; 28319; 28325;
28342 and 28349

PRAIRIE ISLAND INDIAN
COMMUNITY

v.

TREASURE ISLAND CORPORATION

Shirley Hassan, Paralegal Specialist

Petitioner's consented motion filed October 18, 2002
to extend the time for filing various responses is granted.
Trademark Rule 2.128.

The responses are reset in accordance with
petitioner's motion.